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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q56632

RECEIVED

Hidemi SASAKI, et al.

SEP 27 2004

Appln. No.: 09/434,121

Group Art Unit: 2626

Technology Center 2600

Confirmation No.: 3518

Examiner: Mark E. WALLERSON

Filed: November 05, 1999

For: PRINTER AND PRINTING METHOD

REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.111

MAIL STOP AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated June 23, 2004, reconsideration and allowance of the subject application are respectfully requested. Upon entry of this Request, claims 4-9 and 13-17 are pending in the application. Applicant respectfully submits the pending claims define patentable subject matter.

Claims 4, 5, 9, 13 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over newly cited Moriguchi et al. (U.S. Patent No. 5,572,291; hereafter “Moriguchi”) in view of Numata et al. (U.S. Patent No. 5,870,114; hereafter “Numata”). Claims 8 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Moriguchi in view of Numata and Matsumura (U.S. Patent No. 5,110,106; hereafter “Matsumura”). Claims 7 and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Moriguchi in view of Numata and Kumon (U.S. Patent No. 5,208,902). Claims 6 and 15 are rejected under 35 U.S.C. § 103(a) as being

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unpatentable over Moriguchi in view of Numata and Lindstrom et al. (U.S. Patent No. 6,079,807; hereafter "Lindstrom").¹ Applicant respectfully traverses the prior art rejections.

Moriguchi discloses a transparent film for forming a toner image thereon, wherein the transparent film is provided as an optically transparent sheet member having an opaque part. During image formation, the position and conveyance state of the transparent film are detected optically from the opaque part. As shown in Figure 9, a transparent film 117 has an opaque size mark 132 and is set along a paper-supply guide 131 of a paper-supply unit 130 of an image forming apparatus. Mechanical sensors 120 and 123 are disposed to detect the width of the recording medium 117 by the spacing or width of the supply guide 131, and detect whether the recording medium 117 is appropriately fit to the spacing of the supply guide 131. Optical sensors 121 and 122 are respectively disposed at a position A and a position B to detect whether recording material is transparent film or plain paper. Further, if the recording material is transparent film, the optical sensors 121 and 122 detect based on the size mark 132 the designated size of the transparent film 117 (i.e., A3 or A4) and whether the transparent film 117 is disposed on the right or wrong side thereof. For example, assuming that the recording material is a transparent film of size A4 or A3, one of the sensors 121 or 122 shows "0". On the other hand, if the recording material is plain paper, both sensors 121 and 122 show "1".

Independent claim 1 recites in part:

¹ Although statement of the rejection indicates that claims 6 and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Moriguchi in view of Numata and Lindstrom, the Examiner apparently meant to indicate that claims 6 and 15 are rejected based on these references since claims 6 and 15 recite similar limitations.

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an input section operable to automatically input type information representing one of said types of said recording material, wherein ... said type information indicates a size and a type of said recording material, and said input section includes an information recording medium for storing said type information;

...

a sheet supply container, set at said loading slot removably, for containing said recording material, said information recording medium being secured to said sheet supply container;

wherein said input section further includes:

a first contact pattern for outputting said type information from said information recording medium; and

a second contact pattern, connected with said controller, for contacting said first contact pattern in response to setting of said sheet supply container at said loading slot.

Similarly, independent claim 13 recites in part:

containing a recording material in a sheet supply container settable in a printer, wherein an information recording medium is secured to said sheet supply container;

connecting said information recording medium with said printer in response to setting of said sheet supply container in said printer;

automatically inputting type information representing one of said types of said recording material by reading said type information stored in said information recording medium, wherein each of said types of said recording material has at least one printing region having a shape or a position which is different than said at least one printing region of other types of said recording material, and said type information indicates a size and a type of said recording material.

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Applicant respectfully submits that it is quite clear that Moriguchi does not teach or suggest securing an information recording medium (storing type information representing one of the types of the recording material) to the sheet supply container for containing the recording material, as required by the claimed invention. Rather, Moriguchi simply teaches providing an opaque size mark on the transparent film and utilizing optical sensors to detect whether the recording material is transparent film or plain paper and, based on the location of the size mark on the transparent film, detect the size (i.e., A3 or A4) of the transparent film. Nowhere in reasons in support of the rejection of claims 4 and 13 does the Examiner mention or address the claimed information recording medium which stores the type information representing one of the types of the recording material.

The limitations of claims 4 and 13 require that the recording material and the information recording medium are separate elements, and that the information recording medium is secured to the sheet supply container rather than the recording material. On the other hand, Moriguchi teaches that the information recording medium is the opaque mark which is provided on (secured to) the recording material. Accordingly, Applicant respectfully submits that the claim limitation of the information recording medium being secured to the sheet supply container for containing the recording material cannot be construed to read on the recording material (transparent film) or the opaque mark formed on the recording material of Moriguchi since the claims require that the information recording medium is secured to the sheet supply container.

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Further, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to modify Moriguchi to secure the information recording medium to the sheet supply container for containing the recording material, as claimed, since the teachings of Moriguchi are specifically directed to forming a removable opaque mark on transparent sheets and removing this opaque mark would impermissibly change the principle of operation of the cited reference.².

Accordingly, Applicant respectfully submits that independent claims 4 and 13 should be allowable over the cited references.

With regard to dependent claims 6 and 15, the Examiner cites column 3, lines 54-59 of Lindstrom for allegedly disclosing “a ROM for storing type data” and asserts that “it would have been obvious ... to have modified Moriguchi to make the information recording material a ROM ... in order to improve processing.” However, Lindstrom simply discloses that a controller 40 for printer 20 includes a printhead driver 46 and a print mode remapper 48 which can be implemented in software or firmware, which is loaded or embedded in a digital storage medium, such as a ROM, in the printer 20. Nowhere does Lindstrom teach or suggest an information recording medium which is secured to the sheet supply container and stores and outputs (automatically inputs) type information regarding the a size and a type of the recording material contained in the sheet supply container, as required by the claims. Accordingly, Applicant

² If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). See also MPEP 2143.02.

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respectfully submits that the one of ordinary skill in the art would not have been motivated to modify the apparatus of Moriguchi based on the teachings of Lindstrom to include the claimed information recording medium comprising a ROM.

In view of the above, Applicant respectfully submits that claims 4-9 and 13-17 should be allowable because the cited references do not teach or suggest all of the features of the claims, and one of ordinary skill in the art would not have been motivated to combine and/or modify the cited references to produce the claimed invention.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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